

Docket No.: 23.1093

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Hiroyuki SHIBATA et al.

Serial No. 09/760,883

Group Art Unit: 2673

Confirmation No. 4981

Filed: January 17, 2001

Examiner: Vincent E. Kovalick

For: DISPLAY APPARATUS WITH REDUCED NOISE EMISSION AND DRIVING METHOD
FOR THE DISPLAY APPARATUSRECEIVED
CENTRAL FAX CENTER
JAN 28 2005**REQUEST FOR WITHDRAWAL OF PREMATURE "FINAL" STATUS OF OFFICE ACTION**
MAILED JANUARY 12, 2005: MPEP 706.07(a)-(e)

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

INTRODUCTION

The subject Office Action, both in the Summary, Item 2, and in the detailed Action, at page 14, specifies that the Action is made Final. Item 14, moreover, states:

Applicant's Amendment necessitated new ground(s) of rejection presented in this Office Action.

It is respectfully submitted that the final status of the January 12, 2005 Office Action is premature and should be withdrawn. MPEP 706.07(a) – (e).

At page 2 of the Action under the heading "Request for Withdrawal of Final Rejection" the Action concedes that a §112 ¶ 1 rejection of various claims in the Office Action mailed July 28, 2004 was premature since, as Applicants demonstrated in the Request, the specification sufficiently supports the limitations in question. Applicants respectfully note that the successful traverse of the §112 ¶ 1 rejection was unrelated to Applicant's Request for Withdrawal of the Final Status, as premature.

Instead, the Request for Withdrawal of the Final Status, as premature, was on the basis that a §112 ¶ 1 rejection had never therebefore been asserted and the newly raised §112 ¶ 1 rejection moreover was not related to any amendments to the claims.

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Moreover, Applicant's Request of November 12, 2004 presented a second basis supporting the Request for Withdrawal of the Final Rejection as premature in that, contrary to the contention in Item 13 of the Action that the Applicant's amendment necessitated the new grounds of rejection, that statement was erroneous. (See Applicant's Request at page 2 under heading "B. Item 13...").

The current Action of January 12, 2005 repeats identically the prior art rejections of the pending claims, as they were presented in the Action of July 28, 2004 – and, it follows, that the final rejection is premature for the identical reason that the July 28, 2004 final rejection was premature.

WHEN A FINAL REJECTION IS PROPER ON A SECOND ACTION (MPEP 706.07(a))

MPEP 706.07(a) specifies:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art ... of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.

A second or any subsequent action on the merits in any application or patent involved in reexamination proceedings should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed.

(Emphasis added)

The Action of January 12, 2005 rejects numerous claims which were amended to incorporate therein a single word –plasma– derived from respective, original dependent claims.

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For example, see claims 1-3 which were so amended based on the term "plasma" from claim 4/1 (now cancelled) and numerous other such claims. Applicant's amendments thus did not necessitate the introduction of new grounds of rejection since many of the dependent claims reciting "plasma" were previously rejected over other art already of record.

Moreover, many of the claims, indicated either to be allowed or objected to, were amended to include the word --plasma-- see, e.g., claims 6 and 9 whereas other allowed claims such as 7 and 11 were not so amended.

Moreover, the term "plasma," as further provided in MPEP 706.07(a) "should reasonably have been expected to be claimed" by the Examiner.

CONCLUSION

According, the finality of the present Action should be withdrawn and a new, Non-Final Office Action issued, and the same is respectfully requested.

Respectfully submitted,

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Date: Jan. 28, 2005

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I hereby certify that this correspondence is being transmitted via facsimile to: Commissioner for Patents,
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on Jan 28, 2005
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Date 1/28/05